

**REMARKS**

Claims 1, 6, 10, 14, 19, 20, 23, and 25 are currently amended. Applicant respectfully submits that the amendments contained herein are fully supported by the specification and drawings as originally filed and do not contain new matter.

**Claim Rejections Under 35 U.S.C. § 101**

Claims 1, 6, 7, 8, 14, and 19 were rejected under 35 U.S.C. § 101 because the claims are directed toward non-statutory subject matter. The Examiner indicated that it appears the claims are directed toward functional descriptive material, per se, but fail to produce a useful, concrete and tangible result.

Claims 1 and 14 are directed to methods that produce data corresponding to watermarked material. Applicant respectfully submits that data corresponding to watermarked material is a useful, concrete, and tangible result. Claims 6-8 depend from claim 1 and thus include at least the same useful, concrete, and tangible result as claim 1. Claim 19 depends from claim 14 and thus includes at least the same useful, concrete, and tangible result as claim 14. Therefore, applicant respectfully requests that the rejection of claims 1, 6, 7, 8, 14 and 19 under 35 U.S.C. § 101 be removed.

**Claim Rejections Under 35 U.S.C. § 102**

Claims 1-3, 5-6, 14-16, 18-19, and 25 were rejected under 35 U.S.C. § 102(a) as being unpatentable by Applicant admitted prior art (AAPA). Claims 1-9, 12-19, 21, and 25-26 were rejected under 35 U.S.C. § 102(b) as being unpatentable over Uchida (U.S. Patent No. 6,370,258 B1). Applicant respectfully traverses.

Claims 1, 14, and 25, as currently amended, each recite that a control document containing a plurality of watermark images, each watermark image corresponding to watermark data, is printed (claims 1 and 25) or generated (claim 14) and that a first user mark added to the control document after the control document is printed or generated is detected, where the user mark is designative of a selected one of the watermark images. There is no indication or suggestion, in either the Applicant admitted prior art (AAPA) or in Uchida of detecting a first user mark added to the control document after the control document is printed or generated, where the user mark is designative of a selected one of the watermark images. Therefore, neither the Applicant admitted prior art (AAPA) nor Uchida includes each and every recitation of each

of claims 1, 14, and 25, so claims 1, 14, and 25 should be allowed over both the Applicant admitted prior art (AAPA) and Uchida.

Claims 2-9 depend from claim 1 and are thus allowable for at least the same reasons as claim 1. Claims 15-19 depend from claim 14 and are thus allowable for at least the same reasons as claim 14. Claim 26 depends from claim 25 and is thus allowable for at least the same reasons as claim 25.

Applicant believes that the Examiner listed claims 12-13 and 21 in paragraph 4 of the Office Action as being unpatentable over Uchida in error in that claims 12-13 depend from claim 10 and claim 21 depends from claim 20 and neither claim 10 nor claim 20 is indicated as being unpatentable over Uchida. Indeed, claims 12-13 and 21 are not addressed in the discussion in subparagraphs (1)-(10) of paragraph 4.

Applicant believes that the Examiner intended to list claims 12-13 and 21 in paragraph 5 of the Office Action as being unpatentable over Monty et al. (U.S. Patent No. 6,956,671) in that claim 12 is addressed in subparagraph (3) of paragraph 5 and claims 13 and 21 are addressed in subparagraph (4) of paragraph 5. Therefore, Applicant will treat claims 12-13 and 21 as though the Examiner intended claims 12-13 and 21 as being unpatentable over Monty et al.

Claims 10-11, [12-13], 20, [21], and 22-24 were rejected under 35 U.S.C. § 102(e) as being unpatentable over Monty et al. (U.S. Patent No. 6,956,671). Applicant respectfully traverses.

Claims 10, 20, and 23, as currently amended, each recite that a control document with one or more thumbnail images is scanned to detect a first user mark designating one of the one or more thumbnail images for selecting the corresponding watermark, that printed material is scanned, and that the watermarked material comprises the printed material and the image of the designated one of the one or more thumbnail images. Applicant respectfully submits that it is clear from the context of each of claims 10, 20, and 23 that the printed material is scanned independently of the control document and that a thumbnail image is added to the printed material. There is no indication of suggestion of this in Monty et al. In Monty et al. (see column 5, line 39, to column 6, line 5), a user manually completes selected user designation areas on a proof sheet and order form 22 (Figure 3A), such as by marking thereon with a marking implement such as a pencil or a pen. This permits the user to select which images to send to final printing, image quantity, image brightness, image cropping, etc. The completed proof sheet

and order form 22 is then manually re-inserted into the input/output media tray 38 (FIG. 2) of the ink jet printer 14, and ink jet printer 14 generates a print sheet 48 (Figure 5) having the images and enhancements (e.g. size, cropping, brightness, etc.) designated by the user on the proof sheet and order form 22. However, there is no indication of the images designated by the user on the proof sheet and order form 22 being added as water marks to printed material that is scanned independently of the proof sheet and order form 22, as in each of claims 10, 20, and 23. Therefore, Monty et al. does not include each and every element of each of claims 10, 20, and 23, so claims 10, 20, and 23 should be allowed.

Claims 11-13 depend from claim 10 and are thus allowable for at least the same reasons as claim 10. Claims 21-22 depend from claim 20 and are thus allowable for at least the same reasons as claim 20. Claim 24 depends from claim 23 and is thus allowable for at least the same reasons as claim 23.

**CONCLUSION**

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2208.

Respectfully submitted,

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